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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,214	06/20/2003	Rachel Watkins	85406DAN	5838

7590

09/24/2004

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Patent Legal Staff  
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EXAMINER
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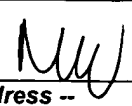
HOGE, GARY CHAPMAN

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 09/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/600,214	<b>Applicant(s)</b> WATKINS ET AL.	
	<b>Examiner</b> Gary C Hoge	<b>Art Unit</b> 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/24/03</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 4, 10, 13, 17-19, 21 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Klein.

Klein discloses a holder for holding at least photographic prints, the holder comprising a first planar member 6 attached to a second planar member 7 through a first fold line 20. Fig. 1 shows that the side ends of the first and second planar members are somewhat expandable to accommodate photographs 4. Klein further discloses a storage slot sized to receive and hold negatives therein (see Fig. 1), the storage slot being attached to an end 9 of the second planar member 7 so as to hang over an outer surface of the second planar member 7; and at least two tabs 23 attached to a top end of said first planar member 7, wherein a first perforated line 21 is defined between the top end of said first planar 7 member and the at least two tabs 23 to permit a removal of each of the tabs from the top end of said first planar member 7.

Regarding claims 4 and 13, Klein discloses a flap 16 extending from the first planar member (and in fact forming a part of the first planar member), the flap extending from a second fold line 19 on the first planar member that is located below the first perforated line 21, the flap extending over the storage slot so as to cover the enclosure.

Regarding claim 29, the customer could, if desired, write on the tabs disclosed by Klein.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 2, 3 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein.

Klein discloses the invention substantially as claimed, as set forth above. However, there are only two tabs disclosed. It would have been obvious to have four tabs because it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

6. Claims 7-9, 12, 14-16, 20, 22, 23, 25-28 and 30-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein in view of Powell.

Klein discloses the invention substantially as claimed, as set forth above. However, the first planar member does not include a tear-out member to expose the inside of the enclosure to view. Powell teaches (see Fig. 9) that it was known in the art to provide a tear-out portion in an

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envelope, in order to make the contents of the envelope visible. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a tear-out member in the first planar member disclosed by Klein, as taught by Powell, in order to make the contents of the enclosure visible.

Regarding claim 8, Powell discloses only one aperture. It would have been obvious to have a plurality of apertures because it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

7. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Klein in view of Powell, as applied to claim 22, above, and further in view of Capozzi et al.

Klein discloses the invention substantially as claimed, as set forth above. However, Klein does not disclose a box for storing the photograph holders. Capozzi teaches that it was known in the art to provide a box for storing photograph holders. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a box, as taught by Capozzi, to store the photograph holders disclosed by Klein, in order to catalog and store the holders for easy retrieval.

8. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein in view of Sawdon.

Klein discloses the invention substantially as claimed, as set forth above. However, Klein does not disclose a transparent member that forms a pocket between the transparent material and the first planar member. Sawdon teaches that it was known in the art to provide a transparent member 22 (see Fig. 6) that forms a pocket. It would have been obvious to one having ordinary

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skill in the art at the time the invention was made to provide the holder disclosed by Klein with a transparent member that forms a pocket, as taught by Sawdon, in order to mail the holder to a desired recipient.


***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C Hoge whose telephone number is (703) 308-3422. The examiner can normally be reached on 5-4-9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Gary C Hoge  
Primary Examiner  
Art Unit 3611

gch